

REMARKS

In the final Office Action, the Examiner rejects claims 1-5, 8-15, and 17-30 under 35 U.S.C. § 103(a) as unpatentable over ANDERLIND et al. (EP Application Publication No. EP 1 139 608 A2) (hereinafter ANDERLIND) in view of RATSCHUNAS et al. (PCT Application Publication No. WO 01/28171 A1) (hereinafter RATSCHUNAS) and further in view of EISINGER (EP Application Publication No. EP 1 289 220 A1). Applicant respectfully traverses this rejection.

By way of the present amendment, Applicant proposes amending claims 1, 5, 9, 20, and 21 to improve form and canceling claims 22-30 without prejudice or disclaimer. Applicant proposes adding new claim 31. No new matter has been added by way of the proposed present amendment. Claims 1-5, 8-15, 17-21, and 31 would be pending upon entry of the present amendment.

Initial Matters

Applicant appreciates the Examiner's suggestions for amending claims 5, 15, and 21.

**Rejection under 35 U.S.C. § 103(a) based on
ANDERLIND, RATSCHUNAS, and EISINGER**

Claims 1-5, 8-15, and 17-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over ANDERLIND in view of RATSCHUNAS and further in view of EISINGER. Applicant respectfully traverses this rejection.

Independent claim 1, amended as proposed, is directed to a method for conditional displaying of an electronic message comprising at least one display condition including a geographical display condition for the message in a portable electronic device, the method comprising: receiving in the portable electronic device the message from an external device; determining in the portable electronic device the geographical position of the portable electronic

device; determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message; and displaying the message in the portable electronic device if the at least one display condition including the geographical display condition is fulfilled. Applicant respectfully submits that ANDERLIND in view of RATSCHUNAS and further in view of EISINGER do not disclose or suggest at least one of the features of claim 1, amended as proposed.

For example, ANDERLIND in view of RATSCHUNAS and further in view of EISINGER do not disclose or suggest determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message. The Examiner concedes that ANDERLIND does not disclose the above feature and relies on the Abstract, Fig. 1, and p. 5, line 9 to p. 6, line 32 of RATSCHUNAS as allegedly disclosing the above features of claim 1 (final Office Action, pp. 2-5). Applicant respectfully disagrees with the Examiner's interpretation of RATSCHUNAS.

At the Abstract, RATSCHUNAS discloses (emphasis added):

The invention proposes a method for delivering messages in a network comprising at least one terminal device, comprising the steps of generating a message (S1), setting a condition for receiving the message (S2, S3), deciding whether the message is to be received by the terminal device on the basis of the condition (S5, S6), and transmitting the message to the terminal device on the basis of the result of the deciding step (S8). By this method, messages are only transmitted to a terminal device if certain condition, e.g., location conditions, are met. The invention also proposes a network system and a message generating device, a message delivering device and a terminal device adapted to the above method.

This section of RATSCHUNAS discloses a method for delivering messages in a network based on a condition for receiving the messages. The Examiner states that this section of RATSCHUNAS “teaches a message filtering design whereby the message can be filtered at either the network or mobile device” (Office Action, p. 5). Applicant respectfully disagrees and

submits that this section of RATSCHUNAS specifically discloses that messages are only transmitted to a terminal device if certain conditions are met. In other words, this section of RATSCHUNAS explicitly discloses that a terminal device does not perform message filtering based on the conditions because the terminal device does not even receive the message until after the filtering is performed. Accordingly, this section of RATSCHUNAS does not disclose or suggest determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message, as recited in claim 1, amended as proposed.

At Fig. 1, RATSCHUNAS illustrates components of a network system for delivering multimedia messages to a terminal device. This section of RATSCHUNAS illustrates that only a server (i.e., MMSC 2) includes a mechanism to determine whether to deliver a multimedia message to the terminal device (i.e., multimedia message delivery deciding means 21). Accordingly, this section of RATSCHUNAS does not disclose or suggest determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message, as recited in claim 1, amended as proposed.

At p. 5, line 9 to p. 6, line 32, RATSCHUNAS discloses:

The location can be detected, for example, by accessing a Mobile Location Centre (MLC) for obtaining the latest position of the terminal. The location could also be available, for example at the home location register (HLR) or visitor location register (VLR). By this measure, the latest position can easily be obtained by referring to network elements already implemented in the network.

Also other conditions for receiving the message are possible. For example, an originator of the messages can be listed in a database of the terminal device, i. e., the mobile station. Hence, if a user of a terminal device is always interested to receive messages from a particular originator, this originator can be included in such a database. Then, receiving of the message can easily be permitted.

Moreover, the originator can belong to a group which is defined on the network side. Thus, if the user of the terminal device is always interested to receive messages from this originator group, this group can be listed in the database.

Furthermore, the recipient of the messages can be in a specific state with respect to willingness to receive messages in general or messages of given type or category. The state of the recipient may be enquired by the deciding means. The category condition of the message may have been set at the originator side automatically by the network, e. g., in order to prevent advertisement type of messaging without permission.

The information regarding the condition for receiving a message can be included in an optional field of the message. Hence, the information necessary to judge whether the deciding step is required can easily be detected within the message.

Furthermore, the terminal device can be determined as being inactive or busy in case it is decided that the condition is not met. By this measure, such a terminal device can be handled in the same way as if the terminal is not available in the moment. That is, no special procedure for handling messages which do not meet the condition is required. Furthermore, it can be decided whether delivering of the message should be tried later again or whether the message should not be delivered at all, as it is possible for a normal communication (e. g., phone call or fax transmission).

A delivery report can be sent to the originator of the message, i. e., the user of the multimedia message generator 1. However, it can be arranged that the delivery report can only be sent if the originator of the message is permitted to receive the delivery report. By this measure, it is taken care of the privacy of a user. That is, by this measure the user can avoid that someone is able to track his location without his consent.

This section of RATSCHUNAS discloses restricting delivery of a multimedia message to a terminal based on the location of the terminal. This section of RATSCHUNAS further discloses that a server determines whether the location of the terminal device fulfills a condition before delivering a multimedia message to the terminal. The Examiner relies on certain portions of this section of RATSCHUNAS as allegedly disclosing “filtering is performed at/by the mobile device” (final Office Action, p. 3 and 5). Applicant respectfully disagrees and submits that this section of RATSCHUNAS does not disclose that a terminal filters any messages. At most, this section of RATSCHUNAS discloses that a message sender can be listed in a database of the terminal. Applicant submits that neither this section nor any other section of RATSCHUNAS discloses that the terminal performs message filtering. In fact, in RATSCHUNAS, the terminal

does not even receive the message until after the filtering is performed (Abstract and pp. 10 and 11). Accordingly, RATSCHUNAS does not disclose or suggest determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message, as recited in claim 1, amended as proposed.

Applicant submits that EISINGER does not cure the deficiencies of ANDERLIND and RATSCHUNAS. EISINGER discloses a system of broadcasting messages from one terminal to other terminals that are in the same area as the originating terminal (paragraph 0004). EISINGER also discloses that a server centrally administers the system and that the server determines which other terminals should receive the broadcast messages based on the location of the other terminals (paragraph 00016). EISINGER does not disclose that any of the other terminals participate in this determination process. Accordingly, EISINGER does not disclose or suggest determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message, as recited in claim 1, amended as proposed.

Moreover, ANDERLIND **teaches away** from determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message. MPEP § 2145 (X)(D) instructs Examiners that (emphasis added):

In addition to the material below, see MPEP § 2141.02 (prior art must be considered in its entirety, including disclosures that teach away from the claims) and MPEP § 2143.01 (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

MPEP § 2145 (X)(D)(2) further instructs Examiners that:

It is improper to combine references where the references teach away from their combination.

Applicant submits that ANDERLIND provides at least two reasons why it would be undesirable to have message filtering performed at a client device or mobile station (paragraph 0003).

Specifically, as the Examiner admits, “Anderlind teaches a “message server” as providing the filtering since he claims that filtering by the mobile will cause battery drain (Para #61)” (emphasis added) (Office Action, p. 4). ANDERLIND further discloses that a “service provider can reduce the undesired traffic on the wireless system (including the air interface) by allowing the subscriber to determine the active profile and filter messages even before the messages are transmitted over the air interface to the mobile station” (emphasis added) (paragraph 0065, See also paragraph 0003) . In other words, ANDERLIND teaches away from performing any message filtering at a mobile station because ANDERLIND specifically discloses that it is undesirable to perform message filtering at a mobile station. If ANDERLIND were modified as the Examiner proposes (i.e., filtering messages at the client device or mobile station), ANDERLIND would become unsatisfactory for its intended purpose or change the principle of operation of a reference (i.e., filtering messages at a server to avoid the negative implications of filtering at a mobile station). One of ordinary skill in the art would, therefore, not be motivated to modify ANDERLIND to determine in the portable electronic device whether the geographical position fulfills the geographical display condition of the message, as recited in claim 1, amended as proposed.

Applicant additionally submits, for the sake of argument, that even if ANDERLIND could be modified to filter messages at the terminal (which Applicant submits it improper for the reasons discussed above), ANDERLIND, RATSCHUNAS, and EISINGER, whether taken alone or in any reasonable combination, still could not disclose displaying the message in the portable electronic device if the at least one display condition including the geographical display condition is fulfilled. More specifically, ANDERLIND, RATSCHUNAS, and EISINGER, are each directed to servers that use certain criteria to determine when to send messages to a client device (See e.g., ANDERLIND at paragraph 0029 and 0030; RATSCHUNAS at page 10, lines

5-30; and EISINGER at paragraph 0009). In other words, if the features of ANDERLIND, RATSCHUNAS, and EISINGER are moved to a client device (as the Examiner proposes), the resulting system would simply be a client device that can determine when to send messages based on the certain criteria and not when to display messages based on the certain criteria. Accordingly, ANDERLIND, RATSCHUNAS, and EISINGER, whether taken alone or in any reasonable combination, do not disclose or suggest displaying the message in the portable electronic device if the at least one display condition including the geographical display condition is fulfilled, as recited in claim 1, amended as proposed.

On page 2 of the final Office Action, the Examiner states:

While the claims put forth that the “mobile station” perform the filtering, the examiner notes that this is a design choice since various processing can be performed either by the network or by the mobile. Many examples exist for this type of concept, eg. location determination, power control, handoff, etc.. In each case, processing can be performed by the network, by the mobile or blended between the two. It truly depends upon the processing power of the mobile.

In other words, the Examiner appears to state that determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message, is a design choice. Applicant respectfully disagrees and submits that such a feature is not a design choice. Specifically, as discussed above, Applicant submits that ANDERLIND states that it is undesirable to perform message filtering at a mobile device. Accordingly, it would not be a design choice to simply change the ANDERLIND’s system perform message filtering at a mobile device.

On page 2 of the final Office Action, the Examiner states:

b. The examiner noted in the his rejection that while Anderlind taught a more “network centric” model, client-server technology is well known and can allow processing by the mobile/client.

In other words, Applicant submits that the Examiner appears to state that determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message is a feature that is well known to one of ordinary skill in the art. Applicant respectfully disagrees that such a feature was well known. Applicant respectfully requests that the Examiner provide evidence supporting that it was known to have a portable electronic device determine whether the geographical position fulfills the geographical display condition of the message. Moreover, as noted above, the disclosure of ANDERLIND teaches away from filtering in a mobile device.

The Examiner further states that (Office Action, pp. 2 and 3):

c. The applicant's claim does not empirically limit exactly how much of the filtering is performed by the network and by the mobile, hence the prior art put forth clearly reads on the claims since they teach a blended processing design (eg. by the network or by the mobile). Anderlind teaches most (if not all) of the processing being performed by the network while Ratschunas teaches the mobile performing much of the processing/filtering.

Applicant submits that Applicant is not required to empirically limit how much filtering is performed by a network or by a mobile. Applicant submits that claim 1 recites, among other elements, determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message. As noted above, the Examiner admits that ANDERLIND does not disclose the above feature of claim 1. Applicant submits that RATSCHUNAS (on which the Examiner relies to resolve the deficiency of ANDERLIND) does not disclose the above feature of claim 1. As discussed above, at most, RATSCHUNAS, discloses that a mobile station can maintain a database of permitted message senders (RATSCHUNAS, p. 5, lines 18-25). RATSCHUNAS does not disclose that the terminal performs any message filtering. As further discussed above, EISINGER does not resolve the deficiencies of either ANDERLIND or RATSCHUNAS.

The Examiner further states that (final Office Action, p. 3):

KSR case law clearly dictates that mere “obvious to try” modification with “known/predicted results” are not novel unto themselves. Hence the argument that the mobile device performed the processing/filtering is essentially moot since this is not uniquely challenging to one skilled and the results are obvious/predicted.

Applicant respectfully disagrees. Applicant submits that the feature of determining in the portable electronic device whether the geographical position fulfills the geographical display condition of the message, as recited in claim 1, amended as proposed, is not obvious to try because ANDERLIND specifically teaches away from such a modification.

For at least the foregoing reasons, Applicant respectfully submits that claim 1 is patentable over ANDERLIND, RATSCHUNAS, and EISINGER, whether taken alone or in any reasonable combination. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) based on ANDERLIND, RATSCHUNAS, and EISINGER.

Claims 2-4 depend from claim 1. Therefore, for at least the reasons given above with respect to claim 1, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) based on ANDERLIND, RATSCHUNAS, and EISINGER.

Independent claim 5 is directed to a method for sending an electronic message in an electronic device, the method comprising: entering display conditions intended for a recipient of the message and set by a transmitting user for conditional display of the electronic message, the conditional display conditions comprising a geographical display condition; appending said display conditions to said electronic message; entering a receiver address to which the electronic message should be sent; sending the electronic message including the geographical display condition to the recipient. Applicant respectfully submits that ANDERLIND in view of

RATSCHUNAS and further in view of EISINGER do not disclose or suggest at least one of the features of claim 5, amended as proposed.

For example, ANDERLIND in view of RATSCHUNAS and further in view of EISINGER do not disclose or suggest sending the electronic message including the geographical display condition to the recipient. In addressing the prior version of claim 5, the Examiner relies on ANDERLIND, RATSCHUNAS, or EISINGER as allegedly disclosing all of the features of claim 5. Without acquiescing in this rejection, Applicant submits that neither ANDERLIND, RATSCHUNAS, EISINGER, whether taken alone or in any reasonable combination, disclose or suggest the above feature of claim 5, amended as proposed.

ANDERLIND discloses a system for allowing a mobile station to create a filtering profile that determines the type and content of data messages that will be sent to the mobile station (Abstract). In ANDERLIND, the filtering profile sets filtering instructions or rules for a user at a receiving terminal that controls delivery, redirection, deletion, content manipulation, priority, or other aspects of data messages (paragraph 0030). ANDERLIND does not disclose that a message sender can determine any rules regarding whether a data message reaches a recipient. Rather, in ANDERLIND, only the receiving user can determine whether a data message is sent to the receiving user. Accordingly, ANDERLIND does not disclose or suggest sending the electronic message including the geographical display condition (set by a transmitting user) to the recipient, as recited in claim 5, amended as proposed.

RATSCHUNAS discloses a system for restricting delivery of a multimedia message to a terminal based on the location of the terminal (Abstract). RATSCHUNAS discloses that a user at a terminal (i.e., a multimedia message generator) can create a message and set a condition to receiving the message that must be satisfied before a destination terminal can receive the message (p. 9). Specifically, in RATSCHUNAS, the user at the terminal can set the condition

such that the message is only transmitted to the destination terminal if the destination terminal is located in a certain area (p. 9). RATSCHUNAS does not disclose that the created message including the set condition is sent to the recipient. Rather, in RATSCHUNAS, the server merely sends the message to the recipient if the set condition is met (p. 10-11). RATSCHUNAS does not disclose that the server sends the message and the set condition to the recipient.

Accordingly, RATSCHUNAS does not disclose or suggest sending the electronic message including the geographical display condition to the recipient, as recited in claim 5, amended as proposed.

EISINGER discloses a system of broadcasting messages from one terminal to other terminals that are in the same area as the originating terminal (paragraph 0004). EISINGER also discloses that a server centrally administers the system and that the server determines which of the other terminals should receive the broadcast messages (paragraph 00016). EISINGER discloses that the broadcasting can be restricted by location and distance (paragraph 0005). Specifically, EISINGER discloses that messages broadcast from a sender can be restricted to other terminals within a cellular area or to other terminals that are within a certain distance from the sending terminal (paragraph 0005). However, EISINGER does not disclose that broadcast messages to the receiving terminals include information regarding the location and distance restrictions. Accordingly, EISINGER does not disclose or suggest sending the electronic message including the geographical display condition to the recipient, as recited in claim 5, amended as proposed.

For at least the foregoing reasons, Applicant respectfully submits that claim 5 is patentable over ANDERLIND, RATSCHUNAS, and EISINGER, whether taken alone or in any reasonable combination. Accordingly, Applicant respectfully requests that the Examiner

reconsider and withdraw the rejection of claim 5 under 35 U.S.C. § 103(a) based on ANDERLIND, RATSCHUNAS, and EISINGER.

Claim 8 depends from claim 5. Therefore, for at least the reasons given above with respect to claim 5, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of this claim under 35 U.S.C. § 103(a) based on ANDERLIND, RATSCHUNAS, and EISINGER.

Independent claims 9 and 20, amended as proposed, recite features similar to (yet possibly different in scope than) those set forth above with respect to claim 1. Accordingly, claims 9 and 20 are patentable over ANDERLIND, RATSCHUNAS, and EISINGER, whether taken alone or in any reasonable combination, for at least reasons similar to the reasons set forth above with respect to claim 1. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 9 and 20 under 35 U.S.C. § 103(a) based on ANDERLIND, RATSCHUNAS, and EISINGER.

Claims 10-14 depend from claim 9. Therefore, for at least the reasons given above with respect to claim 9, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) based on ANDERLIND, RATSCHUNAS, and EISINGER.

Independent claims 15 and 21 (amended as proposed), recite features similar to (yet possibly different in scope than) those set forth above with respect to claim 5. Accordingly, claims 15 and 21 are patentable over ANDERLIND, RATSCHUNAS, and EISINGER, whether taken alone or in any reasonable combination, for at least reasons similar to the reasons set forth above with respect to claim 5. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 15 and 21 under 35 U.S.C. § 103(a) based on ANDERLIND, RATSCHUNAS, and EISINGER.

Claims 17-19 depend from claim 15. Therefore, for at least the reasons given above with respect to claim 15, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) based on ANDERLIND, RATSCHUNAS, and EISINGER.

New claim

Applicant submits that new independent claim 31 recites features similar to (yet possibly of different scope than) features described above with respect to claim 5. Therefore, Applicant submits that this claim is not disclosed or suggested by the art of record.

CONCLUSION

In view of the foregoing proposed amendments and remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the proposed pending claims. Applicant respectfully requests that the Examiner enter the amendment because the amendment does not raise new issues or require a further search of the art. Moreover, Applicant respectfully submits that the proposed amendment places the present application in condition for allowance. In addition, Applicant respectfully submits that entry of this proposed amendment would place the application in better form for appeal in the event that the application is not allowed.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order to expedite prosecution of this application.

As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such assertions (e.g., whether a

reference constitutes prior art, reasons to modify a reference and/or to combine references, assertions as to dependent claims, assertions regarding Official Notice, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070, and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: August 3, 2010

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